

## CORRECTION OF PATENTS

1490

## T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 8/20/03  
 TO: EXAMINER Krm y  
 FROM: T. J. Johnson

APPL. S.N.: 09/812034  
 ART UNIT: 1637

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 8/13/03

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶14.24):
- ☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶14.26.07).
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶14.27.01)
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney "of record" (see ¶¶14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see ¶14.28),
    - ☐ is not recognized as an officer of the assignee (see ¶¶14.29 & possibly 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶14.30).
  - ☐ The T.D. is not signed (see ¶¶14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶14.26, 14.26.04 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see ¶¶14.26, 14.27.02 or 14.27.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see ¶14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_

RETURN THIS MEMO TO

(Rev. 5/98)

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence, including listed enclosures, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 77631 746-3172 on August 13, 2003.

Signature: *Diane M. Tsuda* Diane M. Tsuda

PATENT

Attorney Docket No. A-65353-6/RFT/RMS/RMK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

MAYO, et al.

Serial No. 09/812,034

Filed: March 19, 2001

For: *Apparatus and Method for  
Automated Protein Design*

Group No. 1637

Examiner: Kim, Young J.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence and enclosures are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on:

Date:

Signature

*Diane M. Tsuda*  
Diane M. Tsuda**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Petitioner, **California Institute of Technology**, represents that it is the assignee of the entire right, title, and interest of the instant application, USSN 09/812,034, which is a continuation application of USSN 09/127,926, filed July 31, 1998, now US 6,269,312, which is a continuation application of USSN 09/058,459, filed April 19, 1998, which claims the benefit of USSN 60/087,561, filed June 1, 1998, USSN 60/061097, filed October 3, 1997, USSN 60/054,678, filed August 4, 1997 and USSN 60/043,464, filed April 11, 1997.

Written assignment proof for USSN 09/127,926, is recorded in the U.S. Patent and Trademark Office at Reel/Frame 011165/0779.

California Institute of Technology hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are

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commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, California Institute of Technology does not disclaim the terminal part of any patent granted on the instant application, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee, California Institute of Technology.

I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

CALIFORNIA INSTITUTE OF TECHNOLOGY

Dated: August 12, 2003

By: 

Name: Adam Cochran

Title: The Intellectual Property Counsel